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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,798	02/09/2004	Joseph M. Koenig JR.	TRI4546P0180US	9069
32116 7590 12/10/2007 WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661			EXAMINER PLUMMER, ELIZABETH A	
			ART UNIT 3635	PAPER NUMBER
			MAIL DATE 12/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/774,798

Applicant(s)

KOENIG ET AL.

Examiner

Elizabeth A. Plummer

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4-13 and 15 is/are rejected.
- 7) ☒ Claim(s) 3,14 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendments and arguments received 10/15/2007 have entered and considered. Claim 1 has been canceled. An examination of pending claims 2-16 is herein presented.

Claim Objections

1. Claim 2 recites the limitation "the intermediate strip" in line 15. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests amending the phrase to read, "the intermediate portion".
2. Regarding claim 2, the language between the preamble and portions of the body of the claim are inconsistent. For example, the preamble of the claim 2 sets for the subcombination "a crown molding member"; however the claim recites "extends along the horizontal ceiling" and "extends along the vertical wall" which sets forth a positive relationship between the horizontal wall, vertical wall and the crown molding and thus appears to claim a combination. Clarification is required. For purposes of examination, this claim is being treated as a subcombination.
3. Regarding claim 3, the language between the preamble and portions of the body of the claim are inconsistent. For example, the preamble of the claim 2 sets for the subcombination "a crown molding member"; however, the claim recites "extends along the horizontal ceiling", "extends along the vertical wall" and "bears against the horizontal ceiling" which sets forth a positive relationship between the horizontal wall, vertical wall and the crown molding and thus appears to claim a combination. Clarification is required. For purposes of examination, this claim is being treated as a subcombination.

4. Regarding claim 12, the language between the preamble and portions of the body of the claim are inconsistent. For example, the preamble of the claim 2 sets for the subcombination "a crown molding member"; however, the claim recites "extends along the horizontal ceiling" and "extends along the vertical wall" which sets forth a positive relationship between the horizontal wall, vertical and the crown molding and thus appears to claim a combination. Clarification is required. For purposes of examination, this claim is being treated as a subcombination.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Schiedegger et al. (US Patent 6,212,835).

a. Regarding claim 2, Schiedegger et al. discloses a crown molding member (20), which is useful and capable of trimming a corner defined by where a vertical wall and a horizontal ceiling meet, the crown molding member (20) having a planar portion (80) (Fig. 7,7A), which can extend along a horizontal ceiling when the crown molding member is installed in a first mode and which can extend along the vertical wall when the crown molding member is installed in a second mode, the planar portion (80) having a proximal edge (edge closer to 78) and a distal edge (edge closer to 68), which is spaced from the proximal edge of the

planar portion (Fig. 7,7A), the crown molding member (20) having an intermediate portion (extending from planar portion 80 to flange 74), which adjoins the distal edge of the planar portion at a distal edge of the intermediate portion (Fig. 7,7A), the intermediate portion having a proximal edge (adjacent 74), which is spaced from the distal edge of the intermediate portion (Fig. 7,7A), the crown molding member having a mounting flange (74), which adjoins the proximal edge of the intermediate portion at an the mounting flange (Fig. 7,7A), which can extend along a vertical wall which the crown molding member is installed in the first mode and which extends along a horizontal ceiling when the crown molding is installed in the second mode, wherein the planar portion (80) extends from the distal edge of the intermediate portion toward the corner with the crown member installed in either the first or second mode, the crown molding member having an additional flange (by 76), which adjoins the proximal edge of the planar portion at an adjoining edge of the additional flange (Fig. 7,7A), which can extend along the vertical wall, toward the mounting flange, when the crown molding member is installed in the first mode and which can extend along the horizontal ceiling, toward the mounting flange, when the crown molding member is installed in the second mode.

b. Regarding claim 7, the proximal edge of the planar portion (80) can be proximal to the vertical wall when the crown molding member is installed in the first mode and wherein the proximal edge of the planar portion can be proximal to

the horizontal ceiling when the crown molding member is installed in the second mode.

7. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Soyka, Jr. et al. (US Patent 5,560,175). Regarding claim 12, Soyka Jr. et al. discloses a crown molding member (10), which can be used to trim a corner defined by where a vertical wall and a horizontal ceiling meet, the crown molding member having a planar portion (38), which can extend along a horizontal ceiling when the crown molding member is installed in a first mode (for example, when opened as in Fig. 2 and rotated 90 degrees counterclockwise, the molding can be placed on a suspension ceiling with panels and against a vertical wall) and which can extend along a vertical wall when the crown molding member is installed in a second mode (for example, when opened as in Fig. 2 and rotated 90 degrees the molding can be placed against a vertical wall in between two ceiling sections of different heights), the planar portion having a proximal edge (by 34), the planar portion having a distal edge (by 32) which is spaced from the proximal edge of the planar portion, the crown molding member having an intermediate portion (from 32 to 16), which adjoins the distal edge of the planar portion at a distal edge of the intermediate portion (Fig. 2), the intermediate portion having a proximal edge which is spaced from the distal edge of the intermediate portion (Fig. 2), the crown molding member having a mounting flange (by 28), which can extend along the vertical wall when the crown molding member is installed in the first mode and which can extend along the horizontal ceiling when the crown molding member is installed in the second mode, which generally has a uniform thickness except that the crown molding member

is thinner where the distal edge of the intermediate portion adjoins the distal edge of the planar portion (at 32) (Fig. 2), whereby to form a hinge where the crown molding is thinner (Fig. 2,3).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 4-6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiedegger et al. (US Patent 6,212,835) in view of Keesee (US Patent 3,201,901).

a. Regarding claim 4, Schiedegger et al. discloses the invention as claimed except for the mounting flange including an array of apertures. However, it is notoriously well known in the art that moldings can have an array of apertures on mounting flanges. For example, Keesee teaches a crown molding (Fig. 6) with mounting flanges (17) having an array of apertures (19) in order to more securely fastener the crown molding to the wall. It would have been obvious to one of ordinary skill at the time the invention was made to modify Schiedegger et al. to include an array of apertures on the mounting flange, such as taught by Keesee, in order to more securely attach the molding to the wall or ceiling.

b. Regarding claims 5 and 6, Keesee further teaches that dry-wall finishing material (30) is applied to the mounting flange (column 3, lines 1-5), inherently

having some of the applied material press through at least some of the apertures.

The material can be applied in either mode.

- c. Regarding claim 8, the planar portion can be attached to the ceiling.
- d. Regarding claim 9, the mounting flange can be attached to the vertical wall by means besides applied material, such as by a mechanical fastener (36).
- e. Regarding claim 10, the planar portion can be attached to the vertical wall.
- f. Regarding claim 11, the mounting flange can be attached to the horizontal ceiling by means besides the applied material, such as by a mechanical fastener (36).

10. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soyka, Jr. et al. (US Patent 5,560,175) in view of Schiedegger et al. (US Patent 6,212,835). Regarding claims 13 and 15, Soyka, Jr. et al. discloses an invention capable of being attached to a horizontal ceiling or a vertical wall. Soyka, Jr. et al. does not disclose that the planar portion is attached by mechanical fasteners. However, it is notoriously well known in the art that mechanical fasteners can be used to attach crown moldings to different fixtures. For example, Schiedegger et al. teaches a crown molding (520) comprising a planar portion (561) and an intermediate portion (Fig. 48, 51) wherein the planar portion is attached to a fixture via mechanical fasteners (column 20, lines 31-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Soyka, Jr. et al. to use mechanical fasteners, such as taught by Schiedegger et al. in order to more securely fasten the crown molding.

11. Applicant's arguments with respect to claims 2 and 4-11 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments filed 10/15/2007 have been fully considered but they are not persuasive. Regarding applicant's arguments concerning claim 12, the mounting flange of Soyka is the flange that is adjacent the adhesion surface (28). The rejection of claim 12 has been clarified to show examples of how the molding can be installed in both the first and second mode. In the first mode, the molding can be oriented on a suspension ceiling, the planar portion extending along the ceiling and over the vertical wall such that the mounting flange extends along vertical wall. In the second mode, the molding can be used in a room wherein the ceiling has two adjacent sections that are at different heights. The molding can create a decorative transition between the higher and lower section by placing the planar portion against the vertical wall in-between the two sections and the mounting flange on the lower ceiling section.

Allowable Subject Matter

12. Claims 14 and 16 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claim 3 would be allowable if rewritten or amended to overcome the claim objection(s) set forth in this Office action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Plummer whose telephone number is (571)

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272-2246. The examiner can normally be reached on Monday through Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. CHAPMAN/
PRIMARY EXAMINER

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